THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARK BURNS

_____

Appeal No. 96-0254
Application 08/096,149[1]

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ON BRIEF

_____

Before COHEN, FRANKFORT and KRASS, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12. Subsequent to the final rejection, appellant filed an amendment after final on January 17, 1995

[1] Application for patent filed July 22, 1993.

(Paper No. 5) in which claims 1 through 7 were canceled and claim 8 was amended. The Examiner entered this amendment for purposes of appeal in the Advisory Action mailed to appellant on January 30, 1995[2] and as a result, only claims 8-12 remain for our consideration in this appeal.

Appellant's invention relates to a method of using an undersampling technique to capture, transfer and analyze a multiple word data string. Claim 8 is a representative of the subject matter on appeal and a copy of claim 8, as it appears in the Appendix to appellant's brief, is attached to this decision.

The prior art of record relied upon by the examiner in rejecting appealed claims 8-12 under 35 U.S.C. § 103 is:

Guttag et al. (Guttag)	5,287,100	Feb. 15, 1994 (filed June 27, 1990)

Claims 8-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guttag.

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[2] While the Advisory Action mailed January 30, 1995 indicates that the after final Amendment filed January 17, 1995 was to be entered, the amendment has not physically been entered into the record. Appropriate correction is required.

Rather than reiterate the examiner's explanation of the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejection, we make reference to the first Office Action (Paper No. 2, mailed June 2, 1994), the final rejection (Paper No. 4, mailed November 17, 1994) and the examiner's Answer (Paper No. 11, mailed April 13, 1995) for the examiner's reasoning in support thereof.[3] Appellant's arguments thereagainst are found in the brief (Paper

[3] We note that in the examiner's answer, the examiner referred the Board and appellant to the final rejection (Paper No. 4, mailed November 17, 1994), from which he incorporated the rejection by reference. However, upon review of the record, the final rejection itself refers back to the first Office action (Paper No. 2, mailed June 2, 1994), incorporating the first Office action by reference. See Paper No. 4, page 2, last paragraph. The examiner is referred to the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3, July 1997), Section 1208, which states:

> Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statement of grounds of rejection as appear in a single prior action may be incorporated by reference. . . . Statements of grounds of rejection appearing in actions other than the aforementioned single prior action should be quoted in the answer.

No. 10, filed March 27, 1995) and in the reply brief (Paper No. 12, filed May 19, 1995).

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied Guttag reference, and to the positions set forth by appellant and the examiner. Upon evaluation of the record before us, we will not sustain the examiner's rejection of claims 8-12 under 35 U.S.C. § 103 as being unpatentable over Guttag.

As appellant pointed out on page 3 of the appeal brief, Guttag does not teach, nor render obvious the step of

> repeating the steps of capturing a word of the multiple word data string, analyzing the word's accuracy, and communicating a pass or fail indication until all the words in the multiple word data string have been tested, whereby each repeating step analyzing a subsequent word's accuracy in the multiple word data string and whereby testing of each word of the multiple word data string is accomplished at a fraction of the frequency of the multiple word data string.

Instead, Guttag teaches the summation of bits with a logic level of "one" for a time interval between vertical sync pulses (col. 49, lines 27-30), not the analysis of an individual word. In addition, Guttag teaches away from appellant's invention by teaching a running total of the number of bits with a logic level of "one" (col. 49, lines 48-55), which sums for the entire data string, not appellant's analysis employing a word by word test, in which a word is "captured" for analysis while the rest of the data string is allowed to pass. When the data string is repeated, the next word in the string is captured et cetera, until all the words have been tested at a sampling rate which is a fraction of the clock rate of the circuit under test.

Accordingly, since Guttag fails to teach or render obvious the limitations of claim 8, we cannot sustain the rejection of claims 8-12 under 35 U.S.C. § 103 as being unpatentable over Guttag.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ERROL A. KRASS Administrative Patent Judge	)	

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APPENDIX

8. A method of testing data transfers, comprising the steps of:

transferring a multiple word data string through at least one circuit element and along a bus to a circuit output;

capturing a first word of the multiple word data string as it travels along the bus;

analyzing the first word's accuracy and communicating a pass or fail indication to a test user;

waiting for the multiple word data string transferring through at least one circuit element to repeat at least one time; and

repeating the steps of capturing a word of the multiple word data string, analyzing the word's accuracy, and communicating a pass or fail indication until all the words in the multiple word data string have been tested, whereby each repeating step analyzing a subsequent word's accuracy in the multiple word data string and whereby testing of each word of the multiple word data string is accomplished at a fraction of the frequency of the multiple word data string.